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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,120	05/25/2001	Tommy C. Poon	MH-5077	4933

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Patent Department
Mitsubishi Electric Research Laboratories, Inc.
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Cambridge, MA 02139

EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,120

Applicant(s)

POON, TOMMY C.

Examiner

Daniel S Felten

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt of the Request for Consideration filed April 22, 2004 in response to the January 21, 2004 Office Action is acknowledged. Claims 1 and 3-7 are pending in the application and are presented to be examined upon their merits.

Response to Arguments

2. Applicant's arguments filed April 22, 2004 have been fully considered but they are not persuasive. References, determining obviousness are not read in isolation but for what they fairly teach in combination with the prior art as a whole, and thus patent assignee's reference-by-reference attack on prior art to demonstrate non-obviousness is not persuasive. (Photoelectronic sensing system) Banner Engineering v. Tri-Tronics Co. Inc., 29 USPQ 1392 1389 (CAFC 1993 unpub) citing in re Merck, 231 USPQ 375 (CAFC 1986).

Furthermore references are evaluated by what they suggest to one versed in the art as a whole, rather than their specific disclosure [see In re Bozek, 163 USPQ 545 (CCPA 1969)]. In this case the primary references show the specifics of the applicants' invention with the exception of determining by a user a commercial transaction wherein the user profile is generated and updated by using a mobile agent, forwarding the commercial transaction to a financial institution system therein depending on the profile of the user, and forwarding the commercial transaction from the financial institution system to a selected merchant system which is shown by the secondary reference. The 35 U.S.C § 103(a) rejection set forth below provided reasoning for the combination of references and resolve the level of ordinary skill in the art. As to applicants' piecemeal

and narrow analysis of the references, the examiner submits that the characterization of applicants invention as show in the diagram on page three of applicants' response is merely one interpretation of the claimed subject matter in that the presented limitations within the body of the claim(s) are not necessarily mono-directional or sequentially linked between the user and the financial institution. Again one can not show non-obviousness by attacking references individually where, as here, the rejections are based upon combination of references. Thus the deficiencies of forwarding the commercial transaction to a financial institution system the primary reference that were addressed in the previous action are addressed identically in this action for the applicants' convenience.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hertz (W0/65517) in view of Pitroda (US 5,590,038).

Re claims 1, 6 and 7:

Hertz discloses a method and apparatus for performing a commercial transaction via a network (see Hertz, Abstract),

Specifying a commercial transaction for a user in an apparatus system having a personal access module Connected to the network (Internet), the personal access module operated only by the user (see Hertz, page 2, 11. 3-9., and page 4, 11. 15-24)

Receiving the commercial transaction in an apparatus/system having a personal

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access link (website) (see Hertz, page 2, 11. 3-9,* page 4, 11. 15-24), Hertz fails to disclose a according to a profile determined by a user, a commercial transaction wherein the user profile is generated and updated by using a mobile agent, forwarding the commercial transaction to a financial institution system therein depending on the profile of the user, and forwarding the commercial transaction from the financial institution system to a selected merchant system. These features are disclosed by Pitroda (see Pitroda, Abstract', col. 2, 11. 44+*, col. 3, 11. 4+*, col. 7, 11. 33 to col. 8, 11. 17). Since Hertz disclose a commercial transaction method that includes the use of credit cards accounts to make purchases (see Hertz, page 3, 11. 10+). It would have been obvious for an artisan of ordinary skill in the art at the time of the invention to

substitute the Pitroda card for the credit card in Hertz because an artisan would have sought to the latest technology to provide the aforementioned features along with the flexibility of Pitroda to uniform the various transactions beyond credit card service.

Thus an artisan would have been motivated to use Pitroda in Hertz provide a wider range of uses to that of the credit card. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

Re claim 3:

Hertz in view of Pitroda discloses the personal access module identifies the user and a method of payment (see Hertz, page 2, 11. 3-9., and page 4, 11. 15-24).

Re claim 4:

Hertz in view Pitroda discloses the personal access link is a website operated by the financial institution system (see Hertz, page 2, line 3-9', and page 4, 11. 15-24).

Re Claim 5:

Hertz in view Pitroda discloses the financial institution system is coupled to a plurality of merchant system (see Hertz, page 2, 11. 3-9., and page 4, 11. 15-24).

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF
September 16, 2004

Daniel S Felten
Examiner
Art Unit 3624



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SUPERVISORY PATENT EXAMINER
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